and (B); and

- (ii) applying the composition obtained as a coating on an article within 12 hours of the preparation of the composition.
 - 18. (Newly Added) A coated article prepared by the method of Claim 17.--

REMARKS

Claims 1-9 have been canceled. New Claims 10-18 are active in the case. Reconsideration is respectfully requested.

Applicants hereby affirm that the active claims in the case are the second set of claims numbered 1-9 in the "Amended Sheets".

Claims 1-9 stand rejected based on 35 U.S.C. §112, second paragraph (paragraph 2 of the Office Action). This ground of rejection is believed obviated by the cancellation of Claim 1 in favor of new Claim 10.

Claim 3 stands rejected based on 35 U.S.C. §112, second paragraph. This ground of rejection is believed obviated by the cancellation of Claim 3 in favor of new Claim 12.

Claim 4 stands rejected based on 35 U.S.C. §112, second paragraph. This ground of rejection is believed obviated by the cancellation of Claim 4 in favor of new Claim 13.

Claims 5 and 6 stand rejected based on 35 U.S.C. §112, second paragraph. This ground of rejection is believed obviated by the cancellation of Claims 5 and 6 in favor of new Claims 14 and 15.

Claim 6 stands rejected based on 35 U.S.C. §112, first paragraph. This ground of rejection will be overcome by the filing of a copy of the disclosed ISO 3219 standard, once the same is received from applicants. The filing of the document is expected to occur in the neat

future. The document to be filed will support the subject matter of original claim 6 which is in the form of new Claim 15.

Claims 7-9 stand rejected based on 35 U.S.C. §112, second paragraph. This ground of rejection is believed obviated by the cancellation of Claims 7-9 in favor of new Claims 16-18.

Claims 8 and 9 stand rejected based on 35 U.S.C. §112, second paragraph. This ground of rejection is believed obviated by the cancellation of Claims 8 and 9 in favor of new Claims 17 and 18.

Claims 1-9 stand rejected based on 35 U.S.C. §112, first paragraph. This ground of rejection is believed obviated by the cancellation of Claims 1-9 in favor of new Claims 10-18.

It is now believed that the application is in proper condition for consideration on its merits.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.

Norman F. Oblon

Attorney of Record

Registration No.: 24,618

Frederick D. Vastine, Ph.D.

Registration No.: 27,013



22850

TEL: 703-413-3000 FAX: 703-413-2220

DOCKET NO.: 192286US0PCT

SERIAL NO.: 09/581,560

Marked-Up Copy
Serial No: 09/58/,560
Amendment Filed on:
Since 4,200/

MARKED-UP COPY OF AMENDMENT

IN THE SPECIFICATION

Please amend the specification as follows:

Page 5, line 41, delete "R³: the meaning indicated in Claim 1;" and insert --R³: 5- or 6-membered cycloalkyl radical in which up to three carbon atoms are optionally substituted by C₁-C₄-alkyl groups and one or two ring carbon atoms are optionally substituted by direct attachment of oxygen of an oxygen containing functional group or a tertiary nitrogen atom substituted by two C₁-C₄-alkyl groups;

a C_1 - C_4 -alkyl radical in which one hydrogen atom of the radical is substituted by a 5- or 6-membered cycloalkyl radical in which up to three ring carbon atoms are optionally substituted by C_1 - C_4 -alkyl groups and one or two ring carbon atoms are optionally substituted by direct attachment of oxygen of an oxygen containing functional group or a tertiary nitrogen atom substituted by two C_1 - C_4 -alkyl groups; or

a C_1 - C_4 -alkyl radical substituted by a pyrrolidone group or a morpholine group, wherein bonding of the two heterocyclic groups to the alkyl radical occurs through the ring nitrogen atom of each group.--

IN THE CLAIMS

Please cancel Claims 1-9.

Please add new Claims 10-18 as follows:

- --10. (Newly Added) A mixture, comprising:
- (i) a diisocyanate of formula (I):

OCN—
$$R^1$$
— N — CO — NH — R^2 — NCO

(I)

CO

OR³

wherein each of R¹ and R² has formula (II):

$$-CH_2-CH_2-CH_2-CH_2-CH_2-CH_2-$$
 (II)

(diisocyanate Ia);

wherein one of R¹ or R² has formula (II) and the other radical has formula (III):

$$H_3C$$
 CH_2
 CH_3
(III)

(diisocyanate Ib);

wherein each of R1 and R2 has formula (III)

(diisocyanate Ic);

 R^3 is a 5- or 6-membered cycloalkyl radical in which up to three ring carbon atoms are optionally substituted by C_1 - C_4 -alkyl groups and one or two ring carbon atoms are optionally substituted by direct attachment of oxygen of an oxygen-containing functional group or a tertiary nitrogen atom substituted by two C_1 - C_4 -alkyl groups;

a C_1 - C_4 -alkyl radical in which one hydrogen atom of the alkyl radical is substituted by a 5- or 6-membered cycloalkyl radical in which up to three ring carbon atoms are optionally substituted by C_1 - C_4 -alkyl groups and one or two ring carbon atoms are optionally substituted by direct attachment of oxygen of an oxygen-containing functional group or a tertiary nitrogen atom substituted by two C_1 - C_4 -alkyl groups; or

a C_1 - C_4 -alkyl radical substituted by a pyrrolidone radical or a morpholine radical wherein the site of attachment of the pyrrolidone radical or the morpholine radical to the alkyl group is through the nitrogen atom of the ring system of the two cyclic groups;

(ii) a urethane of formula (IV):

$$OCN - R_1 - NH - CO - OR^3$$
 (IV)

wherein R¹ has formula (II) or (III) above and R³ is as defined above;

(iii) a diisocyanate of formula (V):

OCN
$$- R^{1} - N - CO - N - R^{2} - N - CO - N - R^{4} - NCO$$
 (V)
 $\begin{vmatrix} & & | & | & | \\ & R_{5} & R_{5} & R_{5} & R_{5} \end{vmatrix}$

wherein R^1 , R^2 and R^4 each have the meaning for group R^1 in formula (I), and wherein, of the four R^5 groups, two are hydrogen and the remaining two groups have formula (VI):

$$-CO-O-R^3$$
 (VI)

wherein R³ is as defined above; and

(iv) a monoisocyanurate (VII) prepared from isophorone diisocyanate or

hexamethylene diisocyanate, wherein the weight ratio of diisocyanate (I) to monoisocyanurate (VII) ranges from 10:1 to 1:10.

- 11. (Newly Added) The mixture as claimed in Claim 10, wherein R³ is derived from an alcohol selected from the group consisting of cyclohexanol, cyclohexylmethanol, cyclopentanol, cyclopentylmethanol, 3,3,5-trimethylcyclohexanol, menthol, norborneaol, N-methyl-4-hydroxypiperidine, 4-(2-hydroxyethyl)-morpholine and 4-(2-hydroxyethyl)-pyrrolidone.
- 12. (Newly Added) The mixture as claimed in Claim 10, wherein the amount of isophorone diisocyanate or hexamethylene diisocyanate remaining in the mixture is less than 0.5% by weight of the mixture.
- 13. (Newly Added) The mixture as claimed in Claim 10, wherein the sum of the amounts of diisocyanates (Ia), (Ib), (Ic), (V), the urethane (IV) and the monoisocyanurate (VII) ranges from 10 to 100% by weight, based on the weight of the mixture.
- 14. (Newly Added) A process for preparing the mixture as claimed in Claim 10, which comprises:

reacting

- (i) isophorone diisocyanate, hexamethylene diisocyanate or a mixture of these isocyanates in the presence of a catalyst with
- (ii) a 5- or 6-membered cycloaliphatic alcohol in which up to three ring carbon atoms are optionally substituted by C_1 - C_4 -alkyl groups and one or two ring carbon atoms are optionally substituted by direct attachment of oxygen of an oxygen containing functional group or a tertiary nitrogen atom substituted by two C_1 - C_4 -alkyl groups, or
 - a C₁-C₄-alkyl alcohol in which one hydrogen atom is substituted by a 5- or 6-

membered cycloalkyl radical in which up to three ring carbon atoms are optionally substituted by C_1 - C_4 -alkyl groups and one or two ring carbon atoms are optionally substituted by direct attachment of oxygen of an oxygen containing functional group or a tertiary nitrogen atom substituted by two C_1 - C_4 -alkyl groups; or

a C_1 - C_4 -alkyl alcohol substituted by a pyrrolidone radical or a morpholine radical, wherein the nitrogen containing heterocyclic structures are attached to the alkyl radical by the nitrogen atom of each ring system, the molar ratio of the isocyanates to the monoalcohol ranging from 1.5:1 to 20:1;

- (ii) deactivating the catalyst; and
- (iii) removing unreacted isocyanate.
- 15. (Newly Added) The process as claimed in Claim 14, wherein the reaction is continued until the resulting reaction product after removal of unreacted isophorone diisocyanate or hexamethylene diisocyanate still present has a viscosity ranging from 100 to 10,000 mPas measured by the procedure of ISO 3219, Annex B.
- 16. (Newly Added) A two-component coating composition, comprising: a compound which carries polyisocyanate-reactive groups (component (A)) and the mixture as claimed in Claim 10 (component (B)).
 - 17. (Newly Added) A method of coating articles, which comprises:
- (i) preparing a coating composition as claimed in Claim 16 by mixing components(A) and (B); and
- (ii) applying the composition obtained as a coating on an article within 12 hours of the preparation of the composition.
 - 18. (Newly Added) A coated article prepared by the method of Claim 17.--